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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/632,139	08/03/2000	Ryoichi Imanaka	MAT-3720US4	2101

7590

09/30/2004

Ratner & Prestia
P O Box 980
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EXAMINER

BROWN, RUEBEN M

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 09/30/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/632,139

Applicant(s)

IMANAKA, RYOICHI

Examiner

Reuben M. Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 14.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 14-22 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 14-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horton, (U.S. Pat # 4,945,563) in view of Yoo, (U.S. Pat # 5,497,240).

Considering claim 14, the claimed computer information system comprising a provider for providing information to a recipient reads on the central office connected to the cable TV or satellite distribution system, see col. 3, lines 61-68. The additional claimed feature of the provider charging a different amount to the depending upon whether the information is recorded

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reads on the disclosure of Horton that subscriber's may preview a movie free-of-charge, may be charged a certain amount for viewing the movie and a different amount is charged when the movie is ordered for recording, col. 2, lines 25-67; col. 3, lines 40-55 & col. 4, lines 21-34.

Horton does not teach the further claimed feature of the recording information in the medium being effected responsive to the detection of an identifier that identifies the medium. Nevertheless, Yoo discloses a subscriber video library system that detects that identity of a recording medium before recording, in order to determine whether a new or old tape has been inserted, (col. 4, lines 28-67 & Fig. 2). It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Horton with the technique of effecting a recording a recording responsive to the ID of the recording medium being identified, for the desirable advantage of determining if a newly inserted tape is a new one or an old, as taught by Yoo, col. 5, lines 1-13.

As for the claimed computer information system, Yoo discloses that the user system includes a microcomputer 90, (Fig. 1; col. 3, lines 35-67).

Considering claim 15, the claimed transmission means for transmitting information to the recipient is met by the CATV/satellite distribution system, discussed in Horton, (col. 3, lines 61-64).

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Considering claim 16, the claimed elements of a computer information system that corresponds with subject matter mentioned above in the rejection of claim 14, are likewise rejected. The additionally claimed transmission means for transmitting the information to a recipient is met by the CATV or satellite distribution system discussed in Horton, col. 3, lines 61-67.

Considering claim 17, the claimed steps of a method for processing information corresponds with subject matter mentioned above in the rejection of claim 14, and are likewise rejected.

Considering claim 18, the claimed elements of a method for processing information corresponds with subject matter mentioned above in the rejection of claim 14, and are likewise rejected. As for the different feature of receiving information from a provider, the receiver system of Horton, meets the claimed subject matter, (Fig. 1; col. 3, lines 31-45).

Considering claim 19, the claimed elements of a computer information system that corresponds with subject matter mentioned above in the rejection of claim 14, are likewise rejected. As for the different feature of a recipient for receiving information from a provider, the receiver system of Horton, meets the claimed subject matter, (Fig. 1; col. 3, lines 31-45).

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Considering claim 20, the claimed recipient means for receiving information from a provider is met by the CATV/satellite receiver shown in Fig. 1 & col. 3, lines 31-45. The additionally claimed feature of the recipient being charged a different amount depending upon whether recording of the information is effected, is met by Horton, (col. 2, lines 25-67; col. 3, lines 40-55 & col. 4, lines 21-34).

Horton does not teach the further claimed feature of the recording information in the medium being effected responsive to the detection of an identifier that identifies the medium. Nevertheless, Yoo discloses a subscriber video library system that detects that identity of a recording medium before recording, in order to determine whether a new or old tape has been inserted, (col. 4, lines 28-67 & Fig. 2). It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Horton with the technique of effecting a recording a recording responsive to the ID of the recording medium being identified, for the desirable advantage of determining if a newly inserted tape is a new one or an old, as taught by Yoo, col. 5, lines 1-13.

Considering claim 21, the claimed signal transmitted from a recipient of information to a provider of information, such that the signal indicates whether the information is recorded in a medium, is met by the disclosure in Horton that the decoder 28 could provide billing information to the store and hold circuit 46, which is then transmitted to the proper billing authority, see col. 3, lines 35-60. The instant billing information shows which viewing mode was selected by the subscriber, and thus what charges are being billed.

Considering claim 22, the claimed steps of a method for processing information corresponds with subject matter mentioned above in the rejection of claim 21, and are likewise rejected.

Considering claims 23-28, the claimed system identifier is broad enough to read on the tag or code which indicates whether a program may be taped or not, Horton, col. 2, lines 31-45. Before taping a program, it is required that this tag or code, which is transmitted from the central office, indicate that taping is authorized.

Considering claims 29-34, Horton teaches charging a different amount for recording a movie, this amount is charged, whether or not the subscriber actually views the movie, which is read on the claimed subject matter. It is noted that the claims recite that the different amount is charged irrespective of whether the information "is viewed", which is broader for instance than whether the subscriber is "billed for viewing".

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9306, (for formal communications intended for entry)

Or:

(703) 746-6861 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")


*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).*

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Reuben M. Brown whose telephone number is (703) 305-2399.
The examiner can normally be reached on M-F (8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Andrew I. Faile can be reached on (703) 305-4380. The fax phone numbers for the
organization where this application or proceeding is assigned is (703) 872-9306 for regular
communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the receptionist whose telephone number is (703) 305-4700.

Reuben M. Brown


CHRIS GRANT
PRIMARY EXAMINER